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09/513,646	02/25/2000	DANIEL A FORD	AM9-99-0165	7164
7590	03/31/2008		EXAMINER	
LEONARD T GUZMAN IBM CORPORATION 650 HARRY ROAD SAN JOSE, CA 95120			PHAN, JOSEPH T	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DANIEL A. FORD,  
REINER KRAFT, and GAURAV TEWARI

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Appeal 2007-2625  
Application 09/513,646  
Technology Center 2600

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Decided: March 31, 2008

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Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS,  
and SCOTT R. BOALICK, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 13, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method of inserting messages, such as advertisements, into a telephone conversation with the messages being

relevant to the content of the conversation. *See* generally Spec. 1:6-9.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of interjecting messages into a real-time isochronous discourse between a plurality of users comprising the steps of:

providing a system for accessing a real-time isochronous discourse on a telephone between two or more callers;

accessing a real-time isochronous discourse on the telephone between two or more callers;

monitoring the discourse on the telephone between the callers to determine if the discourse relates to a message desired to be communicated to the callers by the system;

communicating the desired message via the telephone to the callers when the discourse is determined to be related to the desired message; and

continuing the above steps until the discourse being accessed is terminated by the callers or the system.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Ordish	US 5,195,031	Mar. 16, 1993
Sawyer	US 6,351,279 B1	Feb. 26, 2002
		(effectively filed Dec. 18, 1998)
Gerszberg	US 6,396,531 B1	May 28, 2002
		(filed Dec. 31, 1998)

Claims 1, 2, 5, 6, 10, and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ordish in view of Sawyer or Gerszberg.

Claims 3, 4, 7 through 9, 12, and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sawyer in view of Ordish.

We refer to the Examiner's Answer (mailed January 27, 2006) and to Appellants' Brief (filed November 12, 2004) for the respective arguments.

#### SUMMARY OF DECISION

As a consequence of our review, we will reverse the obviousness rejections of claims 1 through 13.

#### OPINION

Appellants contend (Br. 13) that Ordish not only fails to teach the claimed step of monitoring a discourse *on the telephone*, but actually teaches away from the claimed step by disclosing "'characters from the text buffer using the routine readch as described above [and] ... [i]f the characters constitute a recognized word in the vocabulary, a reference to this word is preferably recorded.'" Also, Appellants contend (Br. 14) that Ordish "disavows using a telephone system to monitor discourse between callers" by disclosing that a "'telephone system does not provide any hard copy nor does it allow you to, on the same device, obtain supplementary data while carrying on the conversation.'" Further, Appellants contend (Br. 14) that Sawyer does not monitor a discourse at all and, therefore, does not disclose or suggest monitoring a discourse on the telephone.

The Examiner (Ans. 4) admits that Ordish does not teach that the message-switching network is a telephone network and that the video terminal is a telephone. The Examiner, however, asserts (Ans. 5) that Sawyer and Gerszberg, in the same field of endeavor, teach that it was well-known "to communicate a desired message via a video telephone ('on a telephone') to callers" and "that videophones can communicate across a

packet network and display advertisements to parties during a call," respectively. The issue before us, therefore, is whether a combination of Ordish, and Sawyer or Gerszberg provides for using a telephone to monitor a discourse between callers and to communicate a message to the callers.

Appellants (Spec. 1:21-2:5) explain that advertising using the telephone model usually takes the form of telemarketing or soliciting customers by placing prerecorded calls to them or by playing recordings of advertisements while a caller is on hold. Appellants further refer (Spec. 8:12) to using speech recognition technologies for monitoring a telephone conversation. Appellants state (Spec. 8:22) that the system will "interject (e.g., audio) advertisements," (Spec. 9:14) that it will "interject an audio clip," and (Spec. 9:21) that a caller "may be exposed to an audio clip." From this disclosure, it is clear that Appellants refer to telephone as a communication that at least includes an audio portion. We note that Appellants (Spec. 10:21-23) state that "video-phones and video-conferencing tools may be used for interjecting *not just audio* but video and other multimedia advertisements as well" (emphasis ours). In view of the rest of the disclosure, we interpret "not just audio" as meaning that the advertisements will have at least an audio component, but may also have a video component.

Ordish discloses (col. 2, ll. 57-65) a video communication with a video display for providing textual data messages to subscriber terminals. Throughout the patent, Ordish refers to video communication, video monitors, and displaying conversations. Ordish, therefore, teaches a video communication, not a telephone (i.e., audio) communication. In addition, we agree with Appellants that Ordish teaches away from using a telephone

to monitor discourse between callers by stating (col. 1, ll. 35-40) that telephone systems have the disadvantage of not providing any hard copy or allowing one to obtain supplementary data during a conversation.

Sawyer discloses (abstract, col. 1, ll. 63-65, col. 2, ll. 34-39, etc.) inserting advertisements into a video telephone call using display screens. In other words, Sawyer fails to disclose using a telephone for presenting advertisements to callers. Gerszberg discloses (col. 1, ll. 17-20) implementing menus on a video telephone with a touch-sensitive display screen for interactively displaying video with accompanying audio signals. Gerszberg further discloses (col. 12, l. 66-col. 13, l.9) that the videophone may be used to *display* coupons (which are akin to advertisements), for example. In other words, even though Gerszberg suggests that videophones may have both audio and video components, Gerszberg, like Sawyer, uses the video component, not the telephone/audio component, for communicating advertisements. Therefore, even if Ordish could be combined with Sawyer or Gerszberg, the combination would fail to teach or suggest monitoring a discourse on the telephone and communicating a desired message via the telephone, as recited in independent claims 1, 5, and 10. Consequently, we cannot sustain the obviousness rejection of claims 1, 5, 10, and their dependents, claims 2, 6, and 11, over Ordish and Sawyer or Gerszberg.

Regarding claims 3, 4, 7 through 9, 12, and 13, the Examiner asserts that Sawyer in view of Ordish renders the claims unpatentable. However, each of independent claims 3, 7, and 12 recites monitoring a communication on the telephone and transmitting a desired message via the telephone. As indicated *supra*, neither Ordish nor Sawyer discloses monitoring a

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conversation on the telephone nor transmitting a message via the telephone. Therefore, we cannot sustain the obviousness rejection of claims 3, 4, 7 through 9, 12, and 13.

ORDER

The decision of the Examiner rejecting claims 1 through 13 under 35 U.S.C. § 103 is reversed.

REVERSED

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LEONARD T GUZMAN  
IBM CORPORATION  
650 HARRY ROAD  
SAN JOSE, CA 95120